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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,179	12/28/2001	Takehiro Kaminagayoshi	100809-00114(SCEY 19.304)	7320
26304	7590	11/02/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			KOROBV, VITALI A	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/033,179	Applicant(s) KAMINAGAYOSHI, TAKEHIRO	
	Examiner Vitali Korobov	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

1. This Office Action is in response to the amendment filed on 08/11/2005. Claims 13, 15, 18 and 19 were amended. Claims 13-19 are pending in this Office Action.

Claim Objections

2. The amendment to claim 15 is objected to, because it represents an attempt to re-introduce non-elected subject matter of image processing back into the claims.

All dependent claims are objected to as having the same deficiencies as the claims they depend from.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor's, at the time the application was filed, had possession of the claimed

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invention. Contrary to the Applicant's statement that no new matter has been added, there is no support or mention of "arbitrary information transmitted and received". Therefore, the Applicant's amendment of claims 13, 18 and 19 constitutes introduction of new matter not supported by the specifications.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 13 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,480,885 B1 issued to Olivier, Michael (hereinafter Olivier).

With respect to claim 13, Olivier teaches a network communication system comprising: a plurality of user's terminal devices which are provided with information extracting means for extracting predetermined information associated with a user's trait from input information (Col. 5, lines 23 – 26, Fig. 2, block 208 – extracting of user information. The title of the invention is "Dynamically matching users for group communications based on a threshold degree of matching of sender and recipient predetermined acceptance criteria"), and identifying user's information indicating the user's trait based on the predetermined information extracted, said input information being arbitrary information transmitted and received between the user and a second user via the network, (Abstract, establishing (identifying) individual profiles and criteria, for determining personalized subsets (traits)), object forming means of forming an object corresponding to the traits indicated by the user's information identified by the information extracting means (Col. 5, lines 26 – 27, where user object - a database record; Fig. 4, subscription form for extracting user information; Abstract, establishing (identifying) individual profiles and criteria, for determining personalized subsets (traits)), and communicating means, which is connected with predetermined network, for adding the user's information to the formed object and transmitting the object to which the user's information is added via the network (Col. 5, lines 1 – 5, user information is added to the database via network of a service provider); and an information processing equipment which is provided with storing means for storing the object transmitted via the predetermined network by the communicating means of the terminal devices and

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the user's information added to the objects (Col. 5, lines 26 – 27 – storage of user information), detecting means for detecting the object whose information of the users are identical with each other or close to each other by executing collating processing of the user's information of each object stored in the storing means (Fig. 2, block 212 – matching users; Col. 5, lines 27 – 32), and transmitting means for transmitting the information concerning collating result via the predetermined network to the terminal device of respective users of the object detected by the detecting means (Col. 10, lines 16 – 23; col. 14, lines 29 – 33 – results of matching (collating) are transmitted back to the user).

With respect to claim 14, Olivier teaches the network communication system according to claim 13, wherein the user's information is formed from information indicating at least character or taste of each user (Col. 11, lines 12 – 14; Fig. 4, block 416 indicates user's distaste for "for sale" messages).

With respect to claim 15, Olivier teaches the net communication system according to claim 13, wherein the user's information input to the user's terminal device is formed from sentence information, the information extracting means extracts strings indicating at least character or taste of the user from the sentence information, and the object forming means forms an image (Col. 23, lines 50-52 - icons or other graphic highlighting, associated with the matching users), corresponding to at least character or taste of the user based on the strings extracted by the information extracting means (Col. 6, lines 38 – 42 – inference engine; col. 20, lines 7 - 12).

With respect to claim 16, Olivier teaches the net communication system according to claim 15, wherein the sentence information input to the user's terminal device is formed from sentence information of electronic mails of respective users (Col. 6, lines 38 – 42).

With respect to claim 17, Olivier teaches the net communication system according to claim 13, further comprising: communication control means for making it possible to perform at least chat between the respective users by connecting communication lines between the respective users to which the collating result is transmitted (Col. 23, lines 26 – 27, 32 – 35).

Claim 18 is rejected in view of the above rejection of claims 13 - 17. Claim 18 is essentially the same and has the same scope as claims 13 - 17, except that it sets forth the invention as a method rather than a system, as do claims 13 – 17.

Claim 19 is rejected in view of the above rejection of claims 13 - 17. Claim 19 is essentially the same and has the same scope as claims 13 - 17, except that it sets forth the invention as a computer-readable recording medium having recorded therein a net communication program rather than a system, as do claims 13 – 17.

Response to Arguments

6. Applicant's arguments filed on 08/11/2005 have been fully considered, but they are not persuasive.

The Applicants argue – ***“Therefore, the active profile data entry method of Olivier, relied upon by the Examiner, does not disclose “extracting predetermined information associated with a user's trait from input information and identifying user's information indicating the user's trait based on the predetermined information extracted, said input information being arbitrary information transmitted and received between the user and a second user via the network”.***

The Examiner respectfully disagrees. Amending the claim with the limitation of “arbitrary information transmitted and received between the user and a second user” only broadens the previously rejected claims regarding the information that is extracted, transmitted and received between the users, thereby affirming the teachings of Olivier as grounds for rejection of presented claims.

Further, claim 13, 18 and 19 each claim that the information is extracted from “input information”, and the information that the user of Olivier inputs into the database certainly fits that description. Lines 4-5 of page 6 of the Applicant's disclosure, stating that the information is “formed on the basis of ... text data and so forth on the user side” provide further support for this interpretation.

The Applicant also states that the information is extracted from user's electronic mail. Olivier also creates email archives and stores information contributions from users in a database, with subsequent extraction of that information in order to create an individualized set of web pages for a user from the database, containing contributions only from users in his recipient list,

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rendering this information extraction predetermined (Col. 3, lines 23-32). The Applicant is referred to columns 21-25 of Olivier for discussion of other embodiments of Olivier's invention, providing further support for extraction and filtering, as a form of extraction, of arbitrary predetermined information from input information. Therefore, rejection is respectfully maintained.

The Applicant states – ***“The Examiner has made of record, but not applied, several U.S. patents and a German patent publication. Applicant appreciates the Examiner's implicit finding that these references, whether considered alone or in combination with others, do not render the claims of the present application unpatentable”.***

The first paragraph of the "Conclusion" section reads: "The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR § 1.111(c)."

The citation of said art is cumulative with citation of Olivier, and does not constitute implicit finding that these references, whether considered alone or in combination with others, do not render the claims of the present application unpatentable. Rather, it is an implicit statement that non responsive replies lead to an abandonment of the application.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

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Vitali Korobov
Examiner
Art Unit 2155

VAK
10/29/2005



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SUPERVISORY PATENT EXAMINER